

REMARKS

Status of Claims

Applicant has amended claim 10, 13, and 16 to further emphasize patentable and nonobvious features of the claimed refrigerating machine oil compositions. The claim language of amended claims are supported by the as-filed application, e.g., page 13, line 11 to page 15, line 13, page 66, line 1 to page 68, line 15, and page 73, line 7 to page 77, line 2; and do not introduce new matter.

Double Patenting Rejection

The Examiner provisionally rejected claims 10-18 on the grounds of nonstatutory obviousness-type double patenting over claims 1-9 of copending Application No. 10/565,739. Since no claims are allowable in either of the relevant applications, Applicant respectfully requests that the double patenting rejection be held in abeyance until allowable subject matter is indicated either in the present application or in Application No. 10/565,739. See M.P.E.P § 804(I)(B).

Claim Objection

Claim 10 has been amended to remove the cited informality, i.e., "dibasic acid and a monohydric alcohols," thereby rendering moot the claim objection.

Rejections under 35 U.S.C. §§ 102(b) and 102(e)

Applicant respectfully traverses the rejection of claims 10 and 12 under 35 U.S.C. § 102(b) over U.S. Patent No. 5,403,503 to Seiki et al. ("Seiki"), and the rejection of

claims 10, 12-14, and 16-17 under 35 U.S.C. § 102(e) over U.S. Patent No. 6,667,285 to Kawahara et al. ("Kawahara"),

Amended claim 10 recites, among other things, a refrigerating machine oil composition comprising an ester of a diol or a polyol having 3-20 hydroxyl groups with a fatty acid having 6-20 carbon atoms as a base oil.

Seiki discloses at col. 2, lines 21, a refrigerator oil composition comprising a polyoxyalkylene glycol derivative, but does not disclose at least the above features recited in amended claim 10. Kawahara discloses at col. 3, line 39, a lubricating oil composition comprising hydrocarbon oils, but also does not disclose at least the above features recited in amended claim 10. Since anticipation under § 102 requires that all of the claim elements be disclosed in a single reference, amended claim 10 therefore is not anticipated by either Seiki or Kawahara.

Amended claim 13 recites, among other things, at least one oxygen-containing compound selected from the group consisting of the following (A1)-(A6): (A1) Alkylene oxide adduct of a polyhydric alcohol having 3-6 hydroxyl groups; (A3) Trihydric alcohol having 3-20 carbon atoms apart from (A1); (A4) Dihydric alcohol having 2-20 carbon atoms apart from polyalkylene glycol; (A5) Hydrocarbyl ether of (A1)-(A4); and (A6) Hydrocarbyl ester of (A1)-(A4).

Amended claim 16 recites, among other things, at least one oxygen-containing compound selected from the group consisting of the following (A1), (A4), (A7) and (A8): (A1) Alkylene oxide adduct of a polyhydric alcohol having 3-6 hydroxyl groups; (A4) Dihydric alcohol having 2-20 carbon atoms apart from polyalkylene glycol; (A7) Hydrocarbyl ether of (A1) or (A4); and (A8) Hydrocarbyl ester of (A1) or (A4).

Kawahara does not disclose either at least one oxygen-containing compound selected from the group consisting of the above (A1) - (A6), as recited in amended claims 13, or at least one oxygen-containing compound selected from the group consisting of the above (A1), (A4), (A7) and (A8), as recited in amended claim 16. Amended claims 13 and 16 therefore are not anticipated by Kawahara.

Rejections under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claim 11 under 35 U.S.C. §103(a) over Kawahara.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. M.P.E.P. § 2143.

Claim 11 depends from amended claim 10, and incorporates all of the features recited in amended claim 10. As discussed above, Kawahara neither discloses nor suggests at least an ester of a diol or a polyol having 3-20 hydroxyl groups with a fatty acid having 6-20 carbon atoms as a base oil, as recited in amended claim 10. Claim 11 depends from claim 10, and also incorporates this feature, which is neither disclosed nor suggested by Kawahara. Kawahara, therefore, does not establish a *prima facie* case of obviousness of claim 11. See M.P.E.P. § 2143.

Applicant also respectfully traverses the rejection of claims 15 and 18 under § 103(a) over Kawahara in view of U.S. Patent No. 6,228,282 to Shimomura et al. ("Shimomura").

Claim 15 depends from amended claim 13, and incorporates all of the features recited in amended claim 13. As discussed above, Kawahara neither discloses nor suggests at least at least one oxygen-containing compound selected from the group consisting of the following (A1)-(A6): (A1) Alkylene oxide adduct of a polyhydric alcohol having 3-6 hydroxyl groups; (A3) Trihydric alcohol having 3-20 carbon atoms apart from (A1); (A4) Dihydric alcohol having 2-20 carbon atoms apart from polyalkylene glycol; (A5) Hydrocarbyl ether of (A1)-(A4); and (A6) Hydrocarbyl ester of (A1)-(A4), as recited in claim 13. Shimomura does not cure the deficiency of Kawahara. Shimomura discloses at col. 2, lines 21-40, col. 8, lines 18-31, and col. 8 line 62- col. 9, line 6, a refrigerating machine oil composition comprising an alicyclic polycarboxylic acid ester compound, an epoxy compound and additives, but does not disclose or suggest the above features, which are neither disclosed nor suggested by Kawahara. Kawahara in combination with Shimomura, therefore, establishes no prima facie case of obviousness of claim 15.

Claim 18 depends from amended claim 16, and incorporates all of the features recited in amended claim 16. As discussed above, Kawahara neither discloses nor suggests at least at least one oxygen-containing compound selected from the group consisting of the following (A1), (A4), (A7) and (A8): (A1) Alkylene oxide adduct of a polyhydric alcohol having 3-6 hydroxyl groups; (A4) Dihydric alcohol having 2-20 carbon atoms apart from polyalkylene glycol; (A7) Hydrocarbyl ether of (A1) or (A4); and (A8) Hydrocarbyl ester of (A1) or (A4), as recited in claim 16. Shimomura does not cure the deficiency of Kawahara. Shimomura discloses at col. 2, lines 21-40, col. 8, lines 18-31, and col. 8 line 62- col. 9, line 6, a refrigerating machine oil composition comprising an

alicyclic polycarboxylic acid ester compound, an epoxy compound and additives, but does not disclose or suggest the above features, which are neither disclosed nor suggested by Kawahara. Kawahara in combination with Shimomura, therefore, establishes no prima facie case of obviousness of claim 18.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of the claims, and a timely notice of allowance.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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